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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,660	08/11/2000	Tom Evslin	176/1	9188

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EXAMINER

NGUYEN, BRIAN D

ART UNIT	PAPER NUMBER
2661	4

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

TS

Office Action Summary

Application No.

09/636,660

Applicant(s)

EVSLIN ET AL.

Examiner

Brian D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the application filed 8/11/00.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 3-18 are objected to because of the following informalities:

Claims 3-5, it is suggested to change "Apparatus" to ---The apparatus---.

Claim 6, "a call" in line 3 and "the call" in line 10 seem to refer back to "a telephone call" in line 1. If this is true, it is suggested to change "a call" and "the call" to ---the telephone call---. "a network address" in line 6 seems to refer back to "a network address" in line 2. If this is true, it is suggested to change "a network address" in line 6 to ---the network address---.

Claim 8, it is suggested to change "said call" to ---said telephone call---.

Claim 11, "a call party" in line 3 seems to mean a calling party and refer back to a calling party in line 1. If this is true, it is suggested to change "a called party" to ---the calling party---.

Claim 13, "a data network address" and "a called party" in line 2 seem to refer back to "a network address" in line 2 and "a called party" in line 2 and 1 of claim 11. If this is true, it is suggested to change "a data network address" and "a called party" in line 2 of claim 13 to ---the network address--- and ---the called party---.

Claim 14, "said data network address" in line 1 and "the data network" in line 2 seem to refer back to "a network address" in line 2 and "a packet switched network" in line 2 of claim 11. If this is true, it is suggested to change "said data network address" and "the data network" in claim 14 to ---said network address--- and ---the packet switched network---.

Claim 15 has the same problem as claim 14. It is suggested to change "said data network address" in line 1 to ---said network address---.

Claim 18, "a data network" seems to refer back to "a packet switched network" in line 2 of claim 11. If this is true, it is suggested to change "a data network" to ---the packet switched network---.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "said table entry" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said data network" in line 8. There is insufficient antecedent basis for this limitation in the claim. "and between said third server" in line 14 is unclear.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-7 and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Galasso (6,374,302).

Regarding claims 1 and 2, Galasso discloses an apparatus comprising: a stored table of information (database 555, 565) indicative of a plurality of parties to be contacted and within a local community of interest (zone 100, 200), the stored table including a network address for each party within the local community of interest, and an indicator of which of at least two networks the address is a part (see table 1 in col. 5); at least two network interface units, each for interfacing to a separate one of the at least two networks (PSTN and Internet) for receiving requests to contact parties; and a processor for determining if a request received is a request to contact a party that is within the local community of interest, and if so, completing the contact at the address and over the network stored in the table (see 610, 620, 640 of figure 4).

Regarding claims 3-5, Galasso discloses contacting a Domain Name Server (DNS) over the Internet if the party to be contacted is not in the local community of interest; receiving information from the DNS, to parse the information to ascertain a network address of a second server having a local community of interest of which the party to be contacted is a part, and for establishing communications over the Internet between the apparatus and the second server;

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monitoring signals received from the second server during call setup, and for determining when to begin transmission of audio communications (see 620, 630 of figure 4; col. 1, line 36-col. 2, line 5; col. 5, lines 58-64; col. 7, line 44-col. 8, line 7).

Regarding claim 6, claim 6 is a method claim that has substantially all the limitation of the respective apparatus claims 1-5. Therefore, it is subject to the same rejection.

Regarding claim 7, Galasso discloses the identification of the called party includes an email address associated with the called party (see table 1 in col. 5).

Regarding claims 11-15, claims 11-15 are method claims that have substantially all the limitations of the respective apparatus claims 1-5. Therefore, they are subject to the same rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galasso et al (6,374,302) in view of Miller et al (6,587,867).

Regarding claims 8-10, Galasso discloses the table entry for the called party comprises plural addresses for contacting the called party (see table 1). Galasso does not disclose updating the table through the graphical user interface. However, Miller discloses using the graphical user interface to update the table (subscriber profile) (see col. 4, lines 26-32). Therefore, it would

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have been obvious to a person of ordinary skill in the art at the time the invention was made to use the graphical user interface to update the table as taught by Miller in the system of Galasso because a user update his own table is more convenient than calling an operator to update.

Regarding claims 16-18, Galasso does not disclose the called party may change the table and prioritizing sets of information. However, Miller discloses the called party can change the table (subscriber profile) and prioritizing sets of information (see abstract; figures 10-12; col. 12, line 1-col. 13, line 20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to change the table and prioritize the information as taught by Miller in the system of Galasso so that the called party can control how coming calls should be received.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Foladare et al (6,373,926), Grundvig et al (6,122,502), and Freeman et al (5,428,608).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (703) 305-5133. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read 'Brian Nguyen', with a stylized, cursive script.

Brian Nguyen
11/29/03